

REMARKS

Claims 1, 20-26, and 64 have been amended.

Claims 4-7, 29-31, 34-37, 39-43, 60, and 65-67 have been withdrawn.

Claims 1-7, 9, 20-28, and 60-67 are currently pending in this application.

Claims 1, 2, 20, 29, 37, and 60 are in independent format.

1. Election / Restriction

The Examiner has reconsidered the previous election between Species I and II, and has determined that Species II should no longer be rejoined. Based on Applicant's previous election of Species I, claims 1-3, 9, 20-28, and 61-64, Applicant hereby acknowledges Examiner's reconsideration, and withdraws claims 4-7, 29-31, 34-37, 39-43, 60, and 65-67.

2. Drawings

The Examiner has objected to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner has stated that identifying indicia must be associated with *each of the slots*, or the features cancelled from the claims.

The drawings have been amended such that an identifying indicia is associated with each illustrated slot. Specifically, additional identifying indicia have been added to Figures 7A, 7B, and 16 where appropriate to identify unlabelled slots. A clean set of the amended drawings and a marked up set illustrating the changes made have been provided.

3. Claim Objections

The Examiner has objected to Claims 21-26 due to informalities, and requested correction thereof.

Applicant has amended Claims 21-26 as suggested by the Examiner to correct the identified informalities and to clarify the claim language.

4. Rejections Under 35 U.S.C. § 102

The Examiner's rejection of Claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,174,032 to *Beck* is respectfully traversed.

The MPEP §2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 9 USQP2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Contrary to the Examiner's statements that all elements of independent Claim 1 are disclosed by the '032 *Beck* reference, the required limitation of a single mounting flange assembly, which is configured to provide infinite radial adjustment of contact tips about a spindle shaft between a minimum radial dimension and a maximum radial dimension, to engage each of a plurality of radially spaced lug holes for a plurality of symmetric and axially centered vehicle wheel lug hole configurations, each having a different number of lug holes, is not.

The '032 *Beck* reference discloses a measurement guide designed to measure: (a) the diameter of a wheel center hole; and (b) the placement of the wheel lug holes.

To measure the diameter of a wheel center hole, and to secure the measurement device onto the wheel, bolts (3) are moved along slots (2) until they are arrested by the edge of the center hole of the wheel, at which point they are tightened. (Col. 2, lines 27-34). The bolts (3) do not engage any wheel lug holes. To provide a measure of the placement of the wheel lug hole configurations, a bolt (5) is moved within slots (4a) or (4b) to engage a first lug hole, and a second bolt (7) is moved within slot (6) to engage a second lug hole. Once the two bolts (5,7) are secured in place, the pattern of the lug holes can be determined for purposes of matching with a second wheel rim. (Col. 2, lines 39-66; Col. 3, lines 1-9). The device of the '032 *Beck* reference does not disclose a device which symmetrically engages each of the wheel lug holes for the purpose of retaining a wheel on the shaft of a balancing machine. As such, the rejection of Claim 1 under 35 U.S.C. § 102(b) as being anticipated by the '032 *Beck* reference is improper, and should be withdrawn.

5. Rejections Under 35 U.S.C. § 103

Claims 1, 3, 20-28, and 61-64

The Examiner's rejection of Claims 1, 3, 20-28, and 61-64 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,888,128 to *Mitchell* in view of U.S. Patent No. 5,174,032 to *Beck* is respectfully traversed. The Examiner's stated basis for the rejection is that the '128 *Mitchell* reference discloses all of the features of the claims except for a mounting flange assembly being a single mounting flange assembly able to engage a plurality of radially spaced lug holes. It is the Examiner's contention that the '032 *Beck* reference supplies the missing limitations by disclosing a universal wheel gauge (1) which singularly accommodates a plurality of lug hole spacings, i.e. 3-lug hole

arrangement via slots 2 (Fig. 1), 4-lug hole arrangements (Figure 4A), 5-lug hole arrangements (Figure 4B), 6-lug hole arrangements (Figure 4C), and 8-lug hole arrangements (Figure 4D). Therefore, the Examiner believes it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the mounting flange plates disclosed by the '128 *Mitchell* reference with the singular plate disclosed by the '032 *Beck* reference in order to more conveniently accommodate lug holes on vehicle wheels.

Generally, with respect to the rejection of Claims 1, 3, 20-28, and 61-64, the Examiner's analysis of the teachings of the '032 *Beck* reference is in error. The '032 *Beck* reference can not, and does not, provide a contact for each lug hole in a variety of vehicle wheel rim lug hole patterns. The '032 *Beck* reference only provides bolts (5) and (7) to contact two lug holes in any selected wheel pattern. Bolts (3), which are retained in slots (2) of the '032 *Beck* reference never contact lug holes, but instead, are always secured within the center bore of the vehicle wheel rim assembly to secure the apparatus thereto while in use. (Col. 2, lines 27-34).

The design of the wheel balancing system show in the '128 *Mitchell* reference will not function as intended of combined with the wheel measurement gauge of the '032 *Beck* reference. Specifically, the '128 *Mitchell* reference requires two plates (34, 35) to be arranged parallel to each other, with each plate having a number of slots disposed therein, *tangential to the central bore*, corresponding to a single wheel lug hole pattern, i.e. 3, 4, 5, etc. symmetrically disposed lug holes. Each plate is substantially identical with the other one, but they are arranged inverted relative to each other, such that the slots therein cross one another. (Col. 3, lines 29-33). As the plates

34 and 35 are rotated relative to one another, pin assemblies passing through the openings defined by the intersecting slots are moved simultaneously in a radial direction. (Col. 3, lines 39-54).

In the '032 *Beck* reference, the slots are *radial* to the central bore. If the slot pattern in the '032 *Beck* reference were incorporated into a double-plate configuration as shown in the '128 *Mitchell* reference, rotational movement of the double plates would not result in the movement of any bolts or lug contact pins, since the slots in each plate would be occluded. Hence, the combination of the '032 *Beck* reference and the '128 *Mitchell* reference would completely fail to function as intended, i.e. providing a single adjustable mounting flange assembly which is adjustable to accommodate a plurality of different lug hole patterns, i.e. 3, 4, 5, 6, 8, etc., over a range of radial displacements.

A rejection based upon a modification of a reference that *destroys the intent, purpose, or function of the invention disclosed in the reference*, is not proper, and the *prima facie* case of obviousness fails. There is no reasonable expectation of success, since neither reference provides a solution to the problem of how to accommodate all lugs in a vehicle wheel assembly for a variety of different lug hole patterns and dimensions, using only a single mounting flange assembly. (See: *MPEP 2142, 2143, and 2143.02*). Accordingly, Claims 1, 3, 20-28, and 61-64 are not *prima facie* obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 3,888,128 to *Mitchell* in view of U.S. Patent No. 5,174,032 to *Beck*.

With respect to Claims 1 and 20, the cited combination of the '128 *Mitchell* and '032 *Beck* references further fails to render obvious a system for mounting vehicle wheels in which a single mounting flange assembly is configured to provide infinite

radial adjustment of contact tips about a spindle shaft to engage each lug hole for a plurality of symmetric vehicle wheel lug hole configurations, each having a different number of lug holes. Neither '128 *Mitchell* nor the '032 *Beck* references disclose systems which are capable of engaging each lug hole for a plurality of symmetric vehicle wheel lug hole configurations, each having a different number of lug holes, and hence, the combination thereof is similarly incapable of functioning as required by the limitations of Claims 1 and 20.

With respect to Claims 3, 23, and 61 the cited combination of the '128 *Mitchell* and the '032 *Beck* references would be non-functional as to the required limitation that rotational movement of the adjusting plate relate to the flange plate alter a radial position of each unobstructed passage in the mounting flange assembly through which the guide pins are placed. The slots in the '128 *Mitchell* reference are tangential to a central bore, while the slots in the '032 *Beck* reference are radial. Rotational movement of two plates having these different slot arrangements would not produce radial movement of openings there through, but rather, would occlude such openings upon any rotational change in position.

With respect to Claim 21, the cited combination of the '128 *Mitchell* and the '032 *Beck* references further fails to render obvious the use of a configuration of slots in the flange plate which is different from the configuration of slots in the adjusting plate, as the '128 *Mitchell* reference teaches to use identical, but inverted slot patterns in each plate. (Col. 3, lines 29-31).

6. Allowable Subject Matter

The Examiner's allowance of Claim 2 and 9 is acknowledged.

7. Conclusion

Based on the foregoing, the allowance of all pending claims is requested.

If for any reason the Examiner is unable to allow the application on the next Office Action and feels that an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney for the purpose of arranging such an interview.

Respectfully submitted,

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AMENDED MARKED-UP DRAWINGS

SHOWING CHANGES MADE

U.S. Patent Application No. 10/685,009

Inventors: Gerdes et al.

Entitled: IMPROVED VEHICLE COMPONENT

CENTERING SYSTEM FOR VEHICLE SERVICE DEVICES

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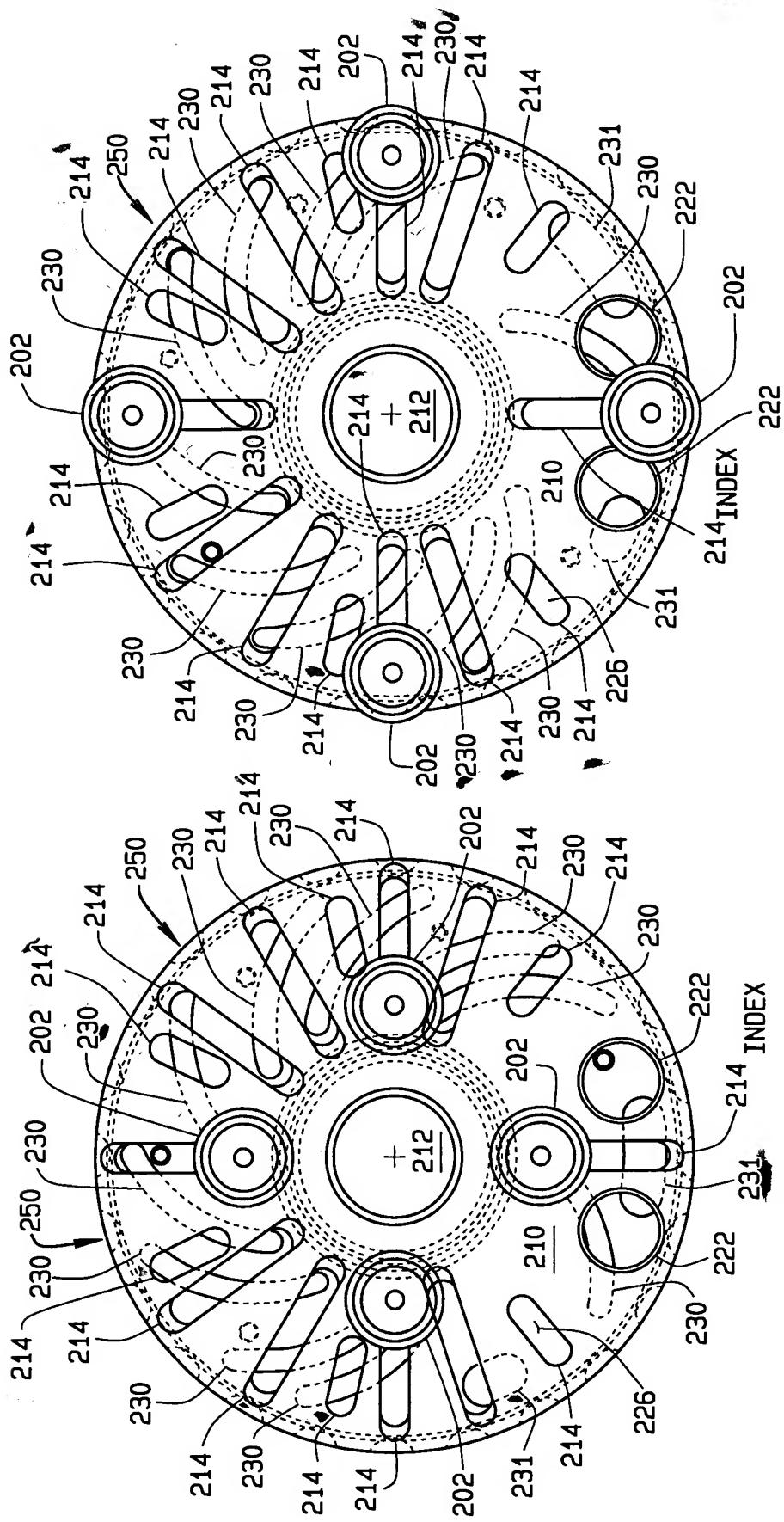


FIG. 7A

FIG. 7B

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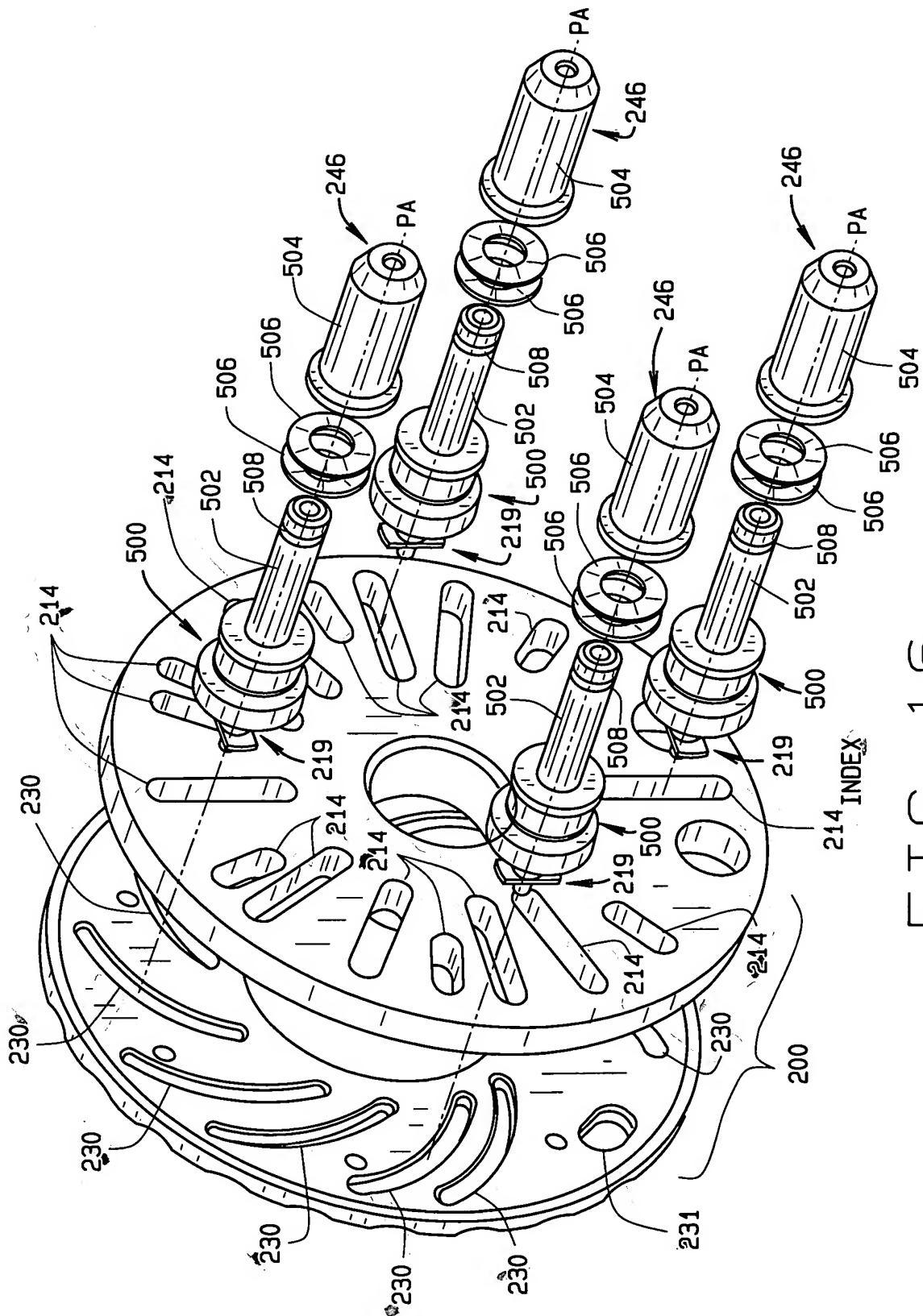


FIG. 16